



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,575	03/15/2001	Borislav Bogdanovic	Studien 280-KGB	5896

7590

07/15/2003

Kurt G. Briscoe, Esq.
Norris McLaughlin & Marcus, P.A.
220 East 42nd Street - 30th Floor
New York, NY 10017

EXAMINER

VOLLANO, JEAN F

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 07/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,575

Applicant(s)

BOGDANOVIC ET AL.

Examiner

Jean F. Vollano

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 15-25 is/are rejected.
- 7) ☒ Claim(s) 10-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____:
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 1621

DETAILED ACTION

1. The request for reconsideration, filed 6/30/2003 has been entered. Claims 1-25 are pending, Claims 1-9 and 15-25 are rejected and claims 10-14 are objected to.
2. Applicant argues that there are no obviousness double patenting since there is no obviousness. Applicant stated that any teaching of the second metal. containing compound which has the property of "increasing the activity of [the] transition metal catalyst" is not taught. The second argument is that there is a showing of unexpected result. These are the two main arguments presented by applicant.

The examiner has already responded to the obviousness type double patenting over US 6,117,372 and has addressed the increasing activity comment.

As for the rejection of instant claims 1-9, 15-21 and 25 over 1-8 and 11-12 of US 6,221,285 again the claims of the patent meet the structural requirements of what is present. The US patents do not have to give a teaching of "increasing the activity of the transition metals". They just must meet the requirements of what is chemically present in the process. If the reagents being claimed are present and the process is present then there is no requirement that a reagent can't be called a catalyst in one invention and a cocatalyst in another invention. It's being present in the same process is the important point. The materials present in the process meet the requirements of the process in both US patents. The compounds taught in the patents as being

Art Unit: 1621

part of the process are found directly in the specifications and the specification can be used to determine the claim language as far as definitions for the process in the claims.

The examiner has pointed out in the patentability rejections and the response why the process and the reagents are obvious variants.

The so called comparative examples have been considered by the examiner. They are not a showing of unexpected results. There is also no data given for the comparisons that the examiner can independently review to make sure that the experiments are truly side by side experiments.

There is no showing of unexpected results and for reasons stated in the previous office actions and for reasons stated above the double patenting rejections are maintained.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

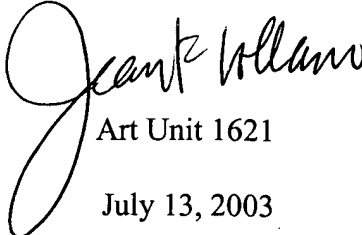
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1621

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr J F Vollano whose telephone number is (703) 305-4483. The examiner can normally be reached on Monday to Thursday from 6:30 to 5:00 .
5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter , can be reached on (703)308-4532 . The official fax phone number for the organization where this application or proceeding is assigned is (703)308-4556. It should be noted that the examiner cannot immediately work on a fax sent to this number.
6. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.

Jean F. Vollano

Primary Examiner


Art Unit 1621
July 13, 2003